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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,310	05/07/2007	Terry O'Halloran	PA1645.ap.US	9252

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EXAMINER	
CHAN, ALLEN	
ART UNIT	PAPER NUMBER
3718	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/591,310	O'HALLORAN ET AL.	
	Examiner	Art Unit	
	ALLEN CHAN	3718	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 January 2011*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In response to the Amendment filed on January 31st, 2011, claims 1, 7, 9, 14 and 15 have been amended. Claims 1-15 are currently pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 15, it is unclear how a computer software product can comprise only a processor and a video monitor in communication with the processor. Generally, computer software is embodied by some form of code/instructions stored on a readable medium or a memory. A processor is used to execute the code stored in the readable medium or memory, but does not store the code for the software. It is suggested that the claim be amended to recite some form of memory or readable medium, in addition to the processor and video monitor.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to a computer software product, which is a computer program *per se*, which is non-statutory subject matter. The examiner suggests that the claim be amended to recite "a non-transitory computer readable medium containing a computer software product..., adapted to implement the method of claim 1".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks et al. (US 2003/0236116 A1) in view of Ward (US Provisional Application 60/454,822, filed 3/13/2003, as shown by US 2004/0180714 A1).

Regarding claims 1 and 9, Marks et al. discloses a method of providing a jackpot in a gaming machine used to play a game, said machine having multiple simulated reels used in the game, and at least one pay line, including at least the steps of determining a player's wager (see par. [0006]), playing the game, so that the simulated reels assume a specific configuration showing symbols across said reels used in the game, wherein one or more of said symbols can be a scatter symbol (see figs. 1A-1C and par. [0068]), and determining if scatter symbols appear across said reels used in the game in a predefined manner, and if so then paying said jackpot (see par. [0069]). However, Marks et al. does not explicitly disclose that the scatter symbols can be a variable state scatter symbol, the variable states being an active and an inactive state and wherein the probability of a variable state scatter symbol is dependent upon the size of the player's wager. Ward teaches a game where the paylines can be active or inactive and where the variable state of the paylines is dependent on the size of the player's wager (see par. [0061]). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to apply the concept of a variable state symbol/payline dependent on a wager amount as taught by Ward to the game and scatter symbol of Marks et al. in order to allow the player to increase the probability of winning by wagering a higher amount.

Regarding claims 2 and 10, Ward teaches that the paylines are activated based on a linear relationship with the player's wager amount (i.e. each multiple of the base bet activates another payline) (see par. [0061]).

Regarding claims 3 and 11, Marks et al. discloses scatter and wild symbols for a game (see par. [0068]-[0070]). It is obvious that these symbols can be used in any manner in a game, at the discretion of the casino operator.

Regarding claims 4 and 12, Ward teaches that the variable state of the paylines is dependent on the size of the player's wager relative to a maximum possible wager (see par. [0061]).

Regarding claims 5 and 6, Marks et al. discloses that the jackpot can be accumulated across a plurality of linked machines or on a single machine (see par. [0011]).

Regarding claims 7 and 14, the limitations of the claim have been discussed above with regards to claims 1 and 4 (for claim 7) and claims 9 and 12 (for claim 14).

Regarding claims 8 and 13, Ward teaches a plurality of gaming machines linked to a central jackpot controller (see par. [0096]). Marks et al. also discloses providing a progressive jackpot which is incremented from wagers on a plurality of machines (see par. [0011]).

Regarding claim 15, Ward teaches a computer program executed by the processor (see par. [0032]) and a video monitor (see fig. 1, item 24).

Response to Arguments

8. Applicant's arguments filed January 31st, 2011 have been fully considered but they are not persuasive.

Regarding applicant's argument that neither Marks et al. nor Ward teach a variable state scatter symbol, the examiner disagrees. As discussed above, Marks et al. teaches a gaming machine which uses scatter symbols as a method of providing a jackpot. Ward teaches a game with variable state paylines which can be active or inactive depending on the size of the player's wager. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the concept of a variable state symbol/payline dependent on a wager amount as taught by Ward to the game and scatter symbol of Marks et al. in order to allow the player to increase the probability of winning by wagering a higher amount. In addition, the claims could also be interpreted such that a scatter symbol appearing on an inactive payline would be inactive. For example, if the player places a wager on only one of the paylines and the scatter symbol appears on a different payline, then the scatter symbol would be inactive. However, if the player wagers on every payline (thus requiring a larger wager), and a scatter symbol appears, then the scatter symbol would be active. Thus, the size of the player's wager would affect the probability of the variable state scatter symbol being in an active or an inactive state.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALLEN CHAN whose telephone number is (571)270-5529. The examiner can normally be reached on Monday through Thursday 9:00 AM to 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ALLEN CHAN/
Examiner, Art Unit 3718
2/7/2011

/JAMES S. MCCLELLAN/
Primary Examiner, Art Unit 3718